UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,845	04/24/2001	Tomoyuki Hirota	KYO.P0007	5692

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ART UNIT	PAPER NUMBER
3627	

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/840,845	HIROTA ET AL.
	Examiner	Art Unit
	James A. Kramer	3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>08 December 2004</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1 and 3-11</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1 and 3-11</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention.

Independent claim 1 includes the following limitation on lines 12-20:

"virtual-shop retailer systems established for the various retailers, said virtual-shop

retailer systems each having at least a terminal, and selectively including a Web server, a

database and an application server provided by one of the various retailers, and said Web

server of said e-commerce support system, said database of said e-commerce support

system, and said application server of said e-commerce support system, wherein said

virtual-shop retailer systems each maintain one of said plurality of virtual shops and uses

functions selectively provided by said application servers to accomplish e-commerce"

This wording of this limitation seems to indicate that the virtual-shop retailer systems

contain (or have) said Web server of said e-commerce support system, said database of said e-

commerce support system, and said application server of said e-commerce support system. This

is not possible as those elements are clearly part of the e-commerce support system not the

virtual-shop retailer systems.

Based on the Specification (Figure 3) it appears that Applicant intends for the virtual-

shop retailer systems to have **a connection to** said Web server of said e-commerce support

system, said database of said e-commerce support system, and said application server of said e-

commerce support system. As such, that is how the Examiner will interpret the claims.

(Examiner references the same issue in Claim 7; lines 13-19).

Claim 7 includes the following limitation on lines 9-12:

"sharing the Web server of the e-commerce support system over the Internet, the database of the e-commerce support system, and the application server of the e-commerce support system with the various retailers"

Examiner notes that based on the wording of this limitation it appears that the Web server is shared over the Internet but that the database and the application server are not. Once again based on the Specification (Figure 3) Examiner believes that Applicant intends to have the Web Server, the database and the application server all shared over the Internet. As such, that is how the Examiner will interpret the claims.

Claim 6; line 2 states "selectively provided said application servers". Examiner notes that this should read, "selectively provided by said application servers".

Claim 8; lines 8-9 states, "the second established by connection to the application server". Examiner notes that this should say, "the third system established by connecting to the application server."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 4, 5 and 7 as interpreted by the Examiner are rejected under 35

U.S.C. 102(b) as being anticipated by "Distributed Virtual Malls on the World Wide Web"

(hereinafter Malls).

Malls teaches a shop server provided on which is a virtual shopping mall including a

plurality of virtual shops operated by various retailers. For example, Examiner references page

1; column 2; lines 7-10, " some virtual malls provide coordination features among multiple

virtual stores within the same Web Site."

Malls teaches an e-commerce support system shared with the various retailers via the

Internet, said e-commerce support system including a Web Server, a database and an application

server. First Examiner references page 1; column 2; lines 24-45, "stores participate in the mall

by communicating with an entity known as the mall coordinator." The mall coordinator of Malls

is the e-commerce support system of the present invention.

Next Examiner references page 6; column 1; lines 5-6, "the mall coordinator is

implemented as a set of programs invoked from a Web server". Examiner notes that this

represents the e-commerce support system (mall coordinator) including a Web Server.

Examiner reference Figure 1 on page 2; column 1 to illustrate that the e-commerce

support system (mall coordinator) includes a database.

Lastly, Examiner Malls teaches that one of the main functions of the mall coordinator is to coordinate actions among a group of stores by communicating with the stores using the mall API functions (page 2; column 2; lines 12-14). Examiner notes that mall API functions or Application Programming Interface represents an application server and therefore this teaching represents the e-commerce support system (mall coordinator) includes an application server.

Malls teaches virtual-shop retailer systems established for various retailers, each having a terminal and selectively including a Web Server, a database and an application server and connected to the Web Server, database and application server of the e-commerce support system.

Examiner specifically notes the claim language "selectively including" on line 14 of Claim 1 represents alternative language. As such, the Store systems taught by Malls need only include a terminal and a connection to the e-commerce support system, as it would be recognized that one could select to include none of the additional features (i.e. Web server, database, or application server). However, Examiner asserts that the Malls does in fact teach that the Store systems include all three of the items (i.e. Web server, database, or application server).

Once again referencing Figure 1; Examiner notes that Malls teaches that the Store may be located at remote Web sites. Examiner notes that in order for a store to be at a remote web site the store must have a Web server and a database. In addition, Malls teaches that the Stores must implement API functions in order to communicate with the mall coordinator (page 2; column 2; lines 5-7) and therefore the stores must contain Application Servers to communicate with mall coordinator.

Malls teaches that the virtual-shop retailer systems each maintain one of said plurality of

virtual shops and uses functions selectively provided by said application servers to accomplish e-

commerce. Examiner references Virtual Mall API's starting on page 6; column 1; line 19 and

asserts that API functions are used to display shopping cart, empty shopping cart, commit to

purchase, search of an item, etc (page 6; column 1; lines 26-28), which are clearly represents

accomplishing e-commerce.

Examiner notes that the use of a simple set (modules) of API functions for

communicating with the mall coordinator at taught by Malls (e.g. page 1; column 2; lines 26-28)

represents wherein each function provided by the application server is put into a module (simple

set).

Malls teaches a table storing membership numbers (user ID) assigned to customers by

each of the various retailers (stores) and membership identification numbers (session ID)

assigned to the customers by said e-commerce support system (mall coordinator), a customer

database storing personal data on the customers for each of the membership identification

numbers (User IDs) and a certificate server to authenticate a customer using the table and the

customer database in response to a membership number (User ID) sent by a retailer (store), a

result of the authentication being sent to the terminal of the retailer (store) which has made an

access to the certificate server for customer authentication. Examiner reference Figure 3 on page

5 and page 4; column 1; lines 10-40). Examiner notes that Malls includes a User ID and a

Session ID. The user ID assigned by the stores and the Session ID assigned by the mall

coordinator.

Malls teaches the databases selectively included in the virtual-shop retailer system store

data required by said functions selectively provided by said application severs to accomplish e-

commerce. Examiner references page 6; column 1; lines 19-24, "invoking an API function on

each store". In other words, the API functions which are invoked to accomplish e-commerce are

stored in a database of the Store.

Examiner notes that claim 7 details the method of using the apparatus of claim 1. All

limitations of claim 7 are similarly rejected under the analysis of the limitations of claim 1

detailed above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

Claims 6, 9, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over

"Distributed Virtual Malls on the World Wide Web" (hereinafter Malls) in view of Conklin et

al.

Malls as described in detail above does not teach wherein the functions selectively provided by the application servers include virtual shop creation function, a charge/settlement function and a delivery management function (claims 6 and 9).

Conklin et al. teaches a sponsor created and administered community between sellers and buyers that allows sellers to use remote authoring templates to create a complete Website for immediate integration and activation in the community, to evaluate proposed buyer orders and counteroffers, and to negotiate multiple variables such as price, terms, conditions, etc with a buyer (column 14; lines 4-6 & 9-14). Conklin et al. further teaches the ability to handle payment processing online (column 14; lines 65-67) and the ability to deliver goods without the need to travel to a seller's location (column 15; lines 15-19).

Examiner notes that the web authoring template represents a virtual shop creation function. In addition, the ability to handle payment processing online represents a charge/settlement function. The ability to have a good delivered represents delivery management function. And the ability to negotiate the terms of the sale represents a back office function.

Examiner notes that It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the mall of Malls to include a sponsor created community with remote authoring templates, ability to negotiate terms of a trade, ability to handle payment processing online and ability to deliver goods as taught by Conklin et al. One of ordinary skill would be motivated to combine the references in order to create a knowledgeable community of commerce (column 13; lines 62-64).

Malls as described in detail above does not teach creating the virtual shops using the

virtual shop creation function by providing pre-designed page templates and registering

commodities associated with the virtual shops using the pre-designed templates (claim 11).

Conklin et al. teaches remote web authoring including sample web templates (column 27;

lines 23-40 and creating product catalogs using the web authoring features of the present

invention (column 28; lines 8-10).

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to modify the mall coordinator of Malls in to include a remote authoring tool

with web page templates and product catalog creation as taught by Conklin et al. One of ordinary

skill would have been motivated to combine these references in order to provide a website design

tool that would allow automatic integration into the community (column 10; lines 4-7).

Malls as described in detail above does not teach renting the modules containing the

functions provided by the application server over the Internet (claim 10). Conklin et al. teaches

that before a seller can register with the community they must agree to the terms of the

community including payment for any services (column 27; lines 53-64). In other words, a seller

must pay/rent the services/functions of the mall.

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to modify the virtual mall of Malls to require the stores to rent the functions

provided by the mall coordinator as taught by Conklin et al. On of ordinary skill would have

been motivated to combine the references in order for the mall coordinator to make money.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over "Distributed Virtual Malls on the World Wide Web" (hereinafter Malls) in view of "Ground Rules for Selecting an Application Service Provider" (hereinafter Rules).

Malls as described in detail above fails to teach wherein a first system for a first retailer does not teach a Web server provided by the first retailer, the first system established by connecting to the Web Server of the e-commerce support system, wherein a second system for a second retailer does not have a database provided by the second retailer, the second system established by connecting to the database of the e-commerce support system, and wherein a third system for a third retailer does not have the application server provided by the third retailer, the third system established by connecting to the application server of the e-commerce support system (claim 8).

Rules teaches that Application Service Providers (ASPs) own all or part of the infrastructure on which application reside. Customer then rent the services they require from the ASP. This model is attractive because it allows the customers to share the costs allowing for a much lower cost structure (lines 12-21).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the mall coordinator of Malls to be an ASP and for the new ASP/mall coordinator to rent out the services required by each of the retailers (namely the Web Server, Database or Application Server) on an as needed basis. In other words, the new ASP/Mall Coordinator could rent out the Web Sever, if a retailer didn't have one, or a database if a retailer didn't have one, or the Application Server, if the retailer didn't have one. One of
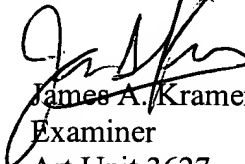
ordinary skill in the art would have been motivated to combine these references in order to help

lower the cost structure for the retailers.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to James A. Kramer whose telephone number is (703) 305-5241.

The examiner can normally be reached on Monday - Friday (8AM - 5PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Richard Chilcot can be reached on (703) 305-4716. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James A./Kramer
Examiner
Art Unit 3627

jak